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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,457	04/08/2004	Morimoto Hidenori	544782000300	1336
25226	7590	01/20/2006	EXAMINER	
MORRISON & FOERSTER LLP 755 PAGE MILL RD PALO ALTO, CA 94304-1018			ROSE, KIESHA L	
			ART UNIT	PAPER NUMBER
			2822	

DATE MAILED: 01/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/821,457	<b>Applicant(s)</b> HIDENORI, MORIMOTO	
	<b>Examiner</b> Kiesha L. Rose	<b>Art Unit</b> 2822	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 24-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/04, 12/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

This Office Action is in response to the election filed 28 October 2005.

### ***Election/Restrictions***

Claims 24-46 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected method of making a semiconductor device, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 28 October 2005.

Applicant's election without traverse of claims 1-23 in the reply filed on 28 October 2005 is acknowledged.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2,5,7,13,17 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 2,5,7,13,17 and 21 disclose the second electrode of the **same** is a metal film; it is unclear what the term **same** is referring too.

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Claims 13,14 and 17 recites the limitation "a first electrode and second electrode" in claims 13,14 and 17. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Gallagher et al. (U.S. Patent 5,640,343).

Gallagher discloses a MRAM (Fig. 2) that contains a memory cell comprising a variable resistive element and a current control element controlling a current flowing in variable resistive element and the current control element is an Schottky diode.

Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by Gallagher.

Gallagher discloses a MRAM (Fig. 2) that contains a memory cell located at positions where word lines (1-3) and bit lines (4-6) are arranged in matrix intersect with each other, the memory cell is constituted by a series circuit including a variable resistive element (78) and an Schottky diode (7) (Column 10, lines 60-65) controlling a current flowing in variable resistive element and one end of the series circuit is connected to the word line and the other to the bit line.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gallagher in view of Yagishita et al. (U.S. Publication 2002/0179980).

Gallagher disclose all the limitations except for the Schottky diode to have an Schottky barrier. Whereas Yagishita discloses a semiconductor device (Fig. 2I) that contains a first electrode (115) of the Schottky diode that is polycrystalline silicon formed in an insulating film, a second electrode (114) which is a metal film deposited on first electrode, a Schottky barrier between first electrode and a metal silicide (Page 3, Paragraph 54) formed between first electrode and second electrode, the resistive element (117) is a perovskite type crystalline structure, the first electrode is a second conductive type impurity region on first conductivity substrate (101) and the second electrode is deposited on impurity region, the semiconductor substrate is a silicon substrate and the impurity region is formed in an element isolation region (102) formed in substrate. An Schottky barrier is formed between the first and second electrode to avoid drain-induced barrier lowering. (Page 3, Paragraph 40) Therefore it would have been obvious to one at the time the invention was made to modify the device of Gallagher by incorporating an Schottky barrier and first and second electrode to avoid drain-induced barrier lowering as taught by Yagishita. In regards to claim 10, that the

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variable resistive element is deposited on second electrode by a self-aligning manner this is a process limitation, a "*product by process*" claim is directed to the product per se, no matter how actually made, *In re Hirao and Sato et al.*, 190 USPQ 15 at 17 (CCPA 1976) (footnote 3). See also *In re Brown and Saffer*, 173 USPQ 685 (CCPA 1972); *In re Luck and Gainer*, 177 USPQ 523 (CCPA 1973); *In re Fessmann*, 180 USPQ 324 (CCPA 1974); and *In re Marosi et al.*, 218 USPQ 289 (CAFC 1983) final product per se which must be determined in a "*product by, all of*" claim, and not the patentability of the process, and that an old or obvious product, whether claimed in "*product by process*" claims or not. Note that Applicant has the burden of proof in such cases, as the above caselaw makes clear. Even though product-by [-] process claims are limited by and defined by the process, determination of patentability is based upon the product itself. The patentability of a product does not depend on its method of production. If the product in product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product is made by a different process." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985)(citations omitted)."

Claims 12-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gallagher in view of Yagishita et al. (U.S. Publication 2002/0179980).

Gallagher disclose all the limitations except for the Schottky diode to have an Schottky barrier. Whereas Yagishita discloses a semiconductor device (Fig. 2I) that contains a first electrode (115) of the Schottky diode that is polycrystalline silicon formed in an insulating film, a second electrode (114) which is a metal film deposited on first electrode, a Schottky barrier between first electrode and a metal silicide (Page 3,

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Paragraph 54) formed between first electrode and second electrode, the resistive element (117) is a perovskite type crystalline structure, the first electrode is a second conductive type impurity region on first conductivity substrate (101) and the second electrode is deposited on impurity region, the semiconductor substrate is a silicon substrate and the impurity region is formed in an element isolation region (102) formed in substrate. An Schottky barrier is formed between the first and second electrode to avoid drain-induced barrier lowering. (Page 3, Paragraph 40) Therefore it would have been obvious to one at the time the invention was made to modify the device of Gallagher by incorporating an Schottky barrier and first and second electrode to avoid drain-induced barrier lowering as taught by Yagishita. In regards to claim 23, that the variable resistive element is deposited on second electrode by a self-aligning manner this is a process limitation, a "*product by process*" claim is directed to the product per se, no matter how actually made, *In re Hirao and Sato et al.*, 190 USPQ 15 at 17 (CCPA 1976) (footnote 3). See also *In re Brown and Saffer*, 173 USPQ 685 (CCPA 1972); *In re Luck and Gainer*, 177 USPQ 523 (CCPA 1973); *In re Fessmann*, 180 USPQ 324 (CCPA 1974); and *In re Marosi et al.*, 218 USPQ 289 (CAFC 1983) final product per se which must be determined in a "*product by, all of*" claim, and not the patentability of the process, and that an old or obvious product, whether claimed in "*product by process*" claims or not. Note that Applicant has the burden of proof in such cases, as the above caselaw makes clear. Even though product-by [-] process claims are limited by and defined by the process, determination of patentability is based upon the product itself. The patentability of a product does not depend on its method of production. If the

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product in product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product is made by a different process." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985)(citations omitted)."


### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kiesha L. Rose whose telephone number is 571-272-1844. The examiner can normally be reached on T-F 8:30-6:00 off Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zandra Smith can be reached on 571-272-2429. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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KLR

  
ZANDRA V. SMITH  
SUPERVISORY PATENT EXAMINER  
1/19/2006